

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: WISH HOLDINGS, LLC

International Class: 44

Serial No.: 78/165,521

Published for Opposition: November 4, 2003

Official Gazette: Page TM 514

Filed: September 18, 2002

Attorney Docket No.: MAKE62538

Mark: THE WISH CENTER and
Design

Services: medical and surgical services

MAKE-A-WISH FOUNDATION OF AMERICA,
an Arizona non-profit corporation,

Opposer,

v.

WISH HOLDINGS, LLC, an Illinois limited
liability company,

Applicant.



12-08-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #78

Opposition No. _____

NOTICE OF OPPOSITION

NOTICE OF OPPOSITION

Seattle, Washington 98101

December 4, 2003

TO THE COMMISSIONER FOR TRADEMARKS

TRADEMARK TRIAL AND APPEAL BOARD:

Opposer, Make-A-Wish Foundation of America ("Make-A-Wish" or "Opposer"), an
Arizona non-profit corporation located at 3550 North Central Avenue, Suite 300, Phoenix,
Arizona, 85012, believes that it would be damaged by registration of the mark THE WISH

12/15/2003 ZLIFT01 00000043 78165521

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NOTICE OF OPPOSITION - 1
MAKE62538282.DOC

CHRISTENSEN
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KINDNESS^{LLC}

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1 CENTER and Design (the "WISH CENTER STAR LOGO"), shown in Application Serial
2 No. 78/165,521, filed on September 18, 2002 by Wish Holdings, LLC ("Wish Holdings" or
3 "Applicant") for "medical and surgical services" in International Class 44 and therefore opposes
4 the same. As grounds for this opposition, Opposer, through its counsel, Christensen O'Connor
5 Johnson Kindness, alleges as follows:

6 1. Make-A-Wish is the world's largest and most well-known wish granting charity,
7 with 75 chapters across the United States and its territories and a network of over 25,000
8 volunteers. Since its inception in 1980, Make-A-Wish has granted the wishes of over 100,000
9 children with life-threatening illnesses. The Make-A-Wish name and mark, as well as the
10 services offered under that name and mark, are famous and well-known throughout the United
11 States.
12

13 2. Among other federally registered and common law trademarks and service marks,
14 Opposer is the owner of the following "Make-A-Wish" marks: MAKE-A-WISH
15 FOUNDATION, Registration No. 1,266,624, registered on February 7, 1984 in International
16 Class 42 for "charitable services relating to terminally ill children"; MAKE-A-WISH,
17 Registration No. 1,570,208, registered on December 5, 1989 in International Class 36 for
18 "charitable fundraising services relating to children with life threatening illnesses"; and MAKE-
19 A-WISH, Registration No. 1,565,443, registered on November 14, 1989 in International
20 Classes 6, 14, 16, 18, 20, 21, 25, 28 for various goods including jewelry, stationery, tote bags,
21 coffee mugs, baseball caps, and t-shirts. Each of these registrations are incontestable pursuant to
22 the provisions of Section 15 of the Lanham Act, 15 U.S.C. § 1065, meaning that the registrations
23 are conclusive evidence of Opposer's exclusive right to use the marks in commerce or in
24
25
26
27

1 connection with the goods and services stated in the registrations, as provided by Section 33(b)
2 of the Lanham Act, 15 U.S.C. § 1115(b). Copies of those registrations are attached as Exhibits
3 A, B, and C hereto. Opposer also owns numerous other federally registered trademarks for
4 charitable fundraising services that incorporate the word "wish," such as SHARE THE POWER
5 OF A WISH, ADOPT-A-WISH, WISHWORKS, THE EYES OF A WISH, and WISHMAKER.

6
7 3. Opposer is the owner of the mark MAKE-A-WISH with swirl-and-star design (the
8 "MAKE-A-WISH STAR LOGO"), Registration No. 2,468,522, which was registered on July 10,
9 2001 in International Class 36 for "charitable fundraising services" and International Class 42 for
10 "charitable services for gravely ill children in the nature of arranging activities and providing
11 donations of goods and services for the children based on their expressed requests." A copy of
12 that registration is attached as Exhibit D hereto.

13
14 4. Opposer has used the MAKE-A-WISH STAR LOGO not only in connection with
15 its charitable fundraising services and its provision of charitable services to children with life-
16 threatening illnesses, but has also used the mark extensively on various promotional products,
17 including shirts, caps, bags, pens, writing pads, pins, picture frames, CD cases, mugs, balloons,
18 and golf balls.

19
20 5. Opposer has been using the MAKE-A-WISH STAR LOGO in commerce
21 consistently since at least as early as November 1999, long prior to Applicant's claimed first use
22 of its WISH CENTER STAR LOGO of July 31, 2001.

23
24 6. Each year, Opposer widely advertises the services it offers throughout the United
25 States under the MAKE-A-WISH FOUNDATION mark and the MAKE-A-WISH STAR LOGO,
26 with an annual advertising placement value of between \$20 and 25 million through print,
27

1 broadcast, internet, and out-of-home advertisements. These advertisements reach every state in
2 the nation, as well as various United States territories. Since Opposer first began use of the
3 MAKE-A-WISH STAR LOGO, the estimated total value of its advertising using that mark is at
4 least \$75 million.

5 7. As a result of Opposer's extensive advertising and exclusive use of the MAKE-A-
6 WISH STAR LOGO, this mark has come to be widely recognized by the public as identifying
7 Opposer exclusively and uniquely as the source of goods and services bearing the mark, and
8 represents enormous goodwill of Opposer.
9

10 8. MAKE-A-WISH FOUNDATION and the MAKE-A-WISH STAR LOGO are two
11 of the most distinctive and well-known service marks and trade names in the charitable services
12 industry; are extraordinarily famous and well-known throughout the United States; and became
13 famous and well-known prior to the date that Applicant acquired any rights in the WISH
14 CENTER STAR LOGO.
15

16 9. Applicant's WISH CENTER STAR LOGO is confusingly similar to the MAKE-
17 A-WISH STAR LOGO and dilutes the distinctive quality of the MAKE-A-WISH STAR LOGO,
18 as both logos prominently featuring the word "wish" along with a swirl-and-star type design, and
19 with both logos having a star dotting the letter "i" in the word "wish."
20

21 10. Both Opposer's services and Applicant's services are marketed to those in need of
22 medical care: Applicant offers its services to adults and children aged 13 and over who are
23 clinically obese, and Opposer offers its services to children between the ages of 2 ½ and 18 who
24 are suffering from life-threatening medical conditions. Both Opposer and Applicant advertise
25 their services on the internet, in newspapers, on national television and in hospitals/medical
26
27

centers.

11. Upon information and belief, Applicant applied to register the WISH CENTER STAR LOGO with full knowledge of Opposer's rights to the MAKE-A-WISH STAR LOGO and with full knowledge of Opposer's existing federal trademark registration for the MAKE-A-WISH STAR LOGO. At a minimum, Applicant is deemed to have been on constructive notice of Opposer's prior rights by virtue of Opposer's existing federal trademark registration.

12. Applicant's application and the presumption of exclusivity that would come from a registration to Applicant of the WISH CENTER STAR LOGO sought to be registered is inconsistent with the prior rights of Opposer in the MAKE-A-WISH STAR LOGO.

13. The use by Applicant of its WISH CENTER STAR LOGO is likely to cause consumers or other members of the public, upon seeing Applicant's mark used in connection with Applicant's goods and services, to believe that Applicant's goods and services are sponsored or authorized by Opposer, that Applicant received permission or authorization to use the mark, or that Applicant's goods and services are somehow affiliated or connected with Opposer.

14. Applicant's commercial use of the WISH CENTER STAR LOGO in connection with its goods and services is also likely to dilute the distinctive quality of Opposer's famous MAKE-A-WISH STAR LOGO to identify and distinguish Opposer exclusively as the source of goods and services provided in connection with the MAKE-A-WISH STAR LOGO.

15. By reason of the foregoing, Opposer is likely to be harmed by the registration of Application Serial No. 78/165,521 for the WISH CENTER STAR LOGO and Applicant is not entitled to a registration for the mark.

WHEREFORE, Opposer respectfully requests that the registration of the mark shown by

1 Application Serial No. 78/165,521 be denied pursuant to Section 2(d) of the Lanham Act,
2 15 U.S.C. § 1052(d); Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a); and Section 43(c) of
3 the Lanham Act, 15 U.S.C. § 1125(c), and that this opposition be sustained.

4 Accompanying the duplicate signed copies of this Notice of Opposition is our Check
5 No. 152249 for the required filing fee in the amount of \$300.00 (\$300.00 per class).
6 Please charge any excess fees to Deposit Account No. 03-1740 of Opposer's counsel noted
7 below.


8 Please direct all correspondence to Cindy L. Caditz of Christensen O'Connor Johnson
9 Kindness^{PLLC} at the following address:

10 Cindy L. Caditz, Esq.
11 Christensen O'Connor Johnson Kindness^{PLLC}
12 1420 Fifth Avenue, Suite 2800
13 Seattle, WA 98101-2347

14 Please direct all telephone calls to Cindy L. Caditz at 206-682-8100.

15 Respectfully submitted,

16 CHRISTENSEN O'CONNOR
17 JOHNSON KINDNESS^{PLLC}

18 
19 Cindy L. Caditz
Attorneys for Opposer

20 I hereby certify that this NOTICE OF OPPOSITION and accompanying Exhibits A-D to
21 U.S. Service Mark Application Serial No. 78/165,521 for the mark THE WISH CENTER and
22 Design is being deposited with the U.S. Postal Service in a sealed envelope as first class mail
23 with postage thereon fully prepaid and addressed to the Commissioner for Trademarks,
Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA 22202-3514, on the
below date.

24 Date: December 4, 2003

Jeffrey Harbert

25 CLC:jh
26
27

Int. Cl.: 42

Prior U.S. Cl.: 100

United States Patent and Trademark Office

Reg. No. 1,266,624

Registered Feb. 7, 1984

OG Date Jan. 23, 1990

~~New Cert.~~

SERVICE MARK
PRINCIPAL REGISTER
REGISTRATION ASSIGNED

MAKE-A-WISH FOUNDATION

MAKE-A-WISH FOUNDATION OF
AMERICA (ARIZONA NON-PROFIT
CORPORATION),

SUITE 936

2600 N. CENTRAL AVENUE

PHOENIX, AZ 85004, ASSIGNEE BY AS-
SIGNMENT AND CHANGE OF NAME
FROM GREICIUS MAKE-A-WISH ME-
MORIAL, INC. (ARIZONA CORPORA-
TION) PHOENIX, AZ

NO CLAIM IS MADE TO THE EXCLU-
SIVE RIGHT TO USE THE WORD
"FOUNDATION", APART FROM THE
MARK AS SHOWN.

FOR: CHARITABLE SERVICES RE-
LATING TO TERMINALLY ILL CHIL-
DREN, IN CLASS 42 (U.S. CL. 100).

FIRST USE 5-8-1980; IN COMMERCE
5-8-1980.

SER. NO. 73-388,530, FILED 9-24-1982.



*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Jan. 23, 1990.*

Jeffrey M. Smith

Int. Cl.: 36

Prior U.S. Cl.: 102

United States Patent and Trademark Office

10 Year Renewal

Reg. No. 1,570,208

Registered Dec. 5, 1989

Renewal Term Begins Dec. 5, 1999

**SERVICE MARK
PRINCIPAL REGISTER**

MAKE-A-WISH

MAKE-A-WISH FOUNDATION OF
AMERICA (ARIZONA NON-PROFIT
CORPORATION),
100 WEST CLARENDON, SUITE 2200
PHOENIX, AZ 850133518

OWNER OF U.S. REG. NO. 1,266,624.

FOR: CHARITABLE SERVICES RE-
LATING TO CHILDREN WITH LIFE
THREATENING ILLNESSES, IN CLASS
36 (U.S. CL. 102).

FIRST USE 5-8-1980; IN COMMERCE
5-8-1980.

SER. NO. 73-765,217, FILED 11-21-1988.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Oct. 12, 1999.*

Int. Cls.: 6, 14, 16, 18, 20, 21, 25 and 28

Prior U.S. Cls.: 2, 3, 13, 22, 28, 32, 37, 38, 39 and 50

United States Patent and Trademark Office

Reg. No. 1,565,443

Registered Nov. 14, 1989

**TRADEMARK
PRINCIPAL REGISTER**

MAKE-A-WISH

MAKE-A-WISH FOUNDATION OF AMERICA
(ARIZONA CORPORATION)
SUITE 936
2600 N. CENTRAL AVENUE
PHOENIX, AZ 85004

FOR: KEY RINGS OF NON-PRECIOUS
METALS, IN CLASS 6 (U.S. CL. 13).

FIRST USE 10-15-1987; IN COMMERCE
10-15-1987.

FOR: JEWELRY, NAMELY, PINS, IN CLASS
14 (U.S. CL. 28).

FIRST USE 10-15-1987; IN COMMERCE
10-15-1987.

FOR: PAPER HOLDERS AND REFILLS
THEREFOR; LOOSE LEAF BINDERS, ME-
CHANICAL PENCILS, PAPER CLIPS, PENS,
STATIONERY PORTFOLIOS, IN CLASS 16 (U.S.
CLS. 37 AND 38).

FIRST USE 10-15-1987; IN COMMERCE
10-15-1987.

FOR: TOTE BAGS, IN CLASS 18 (U.S. CL. 3).

FIRST USE 10-15-1987; IN COMMERCE
10-15-1987.

FOR: LICENSE PLATE HOLDERS
(FRAMES), PLASTIC LUGGAGE TAGS, PRES-

ENTATION PLAQUES (TESTIMONIAL), PLAS-
TIC NAME TAGS AND ORNAMENTAL NOV-
ELTY BUTTONS, IN CLASS 20 (U.S. CLS. 13, 32
AND 50).

FIRST USE 10-15-1987; IN COMMERCE
10-15-1987.

FOR: COFFEE MUGS, IN CLASS 21 (U.S. CL.
2).

FIRST USE 10-15-1987; IN COMMERCE
10-15-1987.

FOR: BASEBALL CAPS; JACKETS, POLO
SHIRTS, SWEATSHIRTS, SWIMSUITS, T-
SHIRTS, IN CLASS 25 (U.S. CL. 39).

FIRST USE 10-15-1987; IN COMMERCE
10-15-1987.

FOR: PLASTIC FLYING DISC, TOY BAL-
LOONS AND YO-YOS, IN CLASS 28 (U.S. CL.
22).

FIRST USE 10-15-1987; IN COMMERCE
10-15-1987.

OWNER OF U.S. REG. NO. 1,266,624.

SER. NO. 750,232, FILED 9-6-1988.

JACQUELINE W. ABRAMS, EXAMINING AT-
TORNEY

Int. Cls.: 36 and 42

Prior U.S. Cls.: 100, 101, and 102

United States Patent and Trademark Office

Reg. No. 2,468,522

Registered July 10, 2001

**SERVICE MARK
PRINCIPAL REGISTER**



MAKE-A-WISH FOUNDATION OF AMERICA
(ARIZONA CORPORATION)
3550 NORTH CENTRAL AVE., SUITE 300
PHOENIX, AZ 85012

FOR: CHARITABLE FUNDRAISING SERVICES,
IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 11-0-1999; IN COMMERCE 11-0-1999.

FOR: CHARITABLE SERVICES FOR GRAVELY
ILL CHILDREN IN THE NATURE OF ARRANGING
ACTIVITIES AND PROVIDING DONATIONS OF

GOODS AND SERVICES FOR THE CHILDREN
BASED ON THEIR EXPRESSED REQUESTS, IN
CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 11-0-1999; IN COMMERCE 11-0-1999.

OWNER OF U.S. REG. NOS. 1,266,624, 1,565,443,
AND 1,570,208.

SN 75-902,558, FILED 1-24-2000.

RON FAIRBANKS, EXAMINING ATTORNEY